

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on December 19, 2003, and the references cited therewith.

Claim 1 has been amended, no claims have been added and no claims have been canceled. Thus, claims 1-41 are now pending in this application.

Comments about the Amendment

Claim 1 has been amended to correct grammatical mistakes and to more clearly point out the invention. These amendments were not for reasons of patentability, but were to more clearly describe the invention.

§103 Rejection of the Claims

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claims 1, 2, 6, 11, 23, 24, 27 and 29 were rejected under 35 USC § 103(a) as being unpatentable over Fowler et al. (U.S. 6302612, hereinafter referred to as Fowler) in view of Gouko (U.S. 6222507, hereinafter referred to as Gouko). Applicant respectfully traverses this rejection because the Office Action has not established a prima facie case of obviousness.

The Office Action has not made a prima facie case of obviousness because it did not provide a teaching or suggestion to combine Fowler with Gouko. The Office Action asserts that "Fowler and Gouko are adaptable to each others invention." However, the MPEP indicates that such an assertion is not enough to provide a motivation to combine the references. The MPEP§2143 states, "Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' 916 F.2d at 682, 16 USPQ2d at 1432." Applicant respectfully submits that the Office Action's assertion is incorret and that the Office Action does not provide a teaching or suggestion to combine the references. Without such a teaching or motivation to combine the cited references, the Office Action has engaged in an improper hindsight analysis of the rejected claims.

Additionally, Applicant respectfully submits that even if there were a suggestion to combine, the cited combination does not teach or suggest each and every element in the rejected claims.

Amended independent Claim 1 recites "a primary set of information and a secondary set of information" where a secondary display device is "used to display the secondary set of information." The Office Action asserts that Fowler's secondary display device is used to display the secondary information from an application. However, Applicant respectfully submits that the Office Action has mischaracterized Fowler. Fowler does not disclose secondary information displayed on a secondary display. Instead Fowler discloses dividing only primary information between subpanels. For example, Fowler states, "a working area can be displayed in the main panel while left and right areas or upper and lower areas [of the same working area] can be displayed in the sub panels, respectively." (Insertion added). (Fowler Col. 5, Lines 52-54.) Fowler also describes "a scene around the car can be displayed in a real manner by being divided

into the sub panels, respectively.” Fowler’s primary information, the car scene, is divided into sub panels. Fowler does not disclose any secondary information.

Amended independent claim 1 also recites “wherein upon extension of the secondary display device, the primary set of information is displayed in a larger viewing area of the primary display device.” However, the Office Action does not point out any passage in Fowler or Gouko that teaches or suggests the “upon extension” limitation cited above. Fowler and Gouko are silent on when or how their primary set of information is displayed in a larger viewing area of their primary display device. Because neither Fowler or Gouko describe reconfiguring their display devices upon extension, presumably their devices must be rebooted after extending the panels in order to achieve the benefits of panel extension. As such, Applicant respectfully submits that Fowler and Gouko, neither alone nor in combination, teach or suggest each and every element of amended independent claim 1.

Independent claims 23 and 33 include limitations similar to those of amended independent claim 1. For the reasons given above, Applicant respectfully submits that Fowler and Gouko, either alone or in combination, do not teach or suggest each and every element of independent claims 23 and 33.

Dependent claims 2, 6, 11, 24, 27, and 29 depend directly or indirectly from claims 1 or 23, and include all the limitations of the claims 1 or 23. For the reasons given above, Fowler and Gouko, either alone or in combination, do not teach or suggest all the limitations of claims 2, 6, 11, 24, 27, and 29.

Claims 13, 16, 17, 21, 34, 39, and 40 were rejected under 35 USC §103(a) as being unpatentable over Fowler in view of Gouko, Rebeske et al (U.S. 6302612, hereinafter referred to as Rebeske), and Haneda et al. (U.S. 5900848, hereinafter referred to as Haneda). Applicant respectfully traverses this rejection.

As noted above, the Office Action does not provide a teaching or suggestion to combine the Fowler and Gouko. The Office Action asserts that “given the purpose of Fowler and Gouko is to extend the primary display area by extending a secondary display, it would have been obvious to the skilled artisan to accomplish this objective by known electro-mechanical control and software reconfiguration methods as taught by Rebeske and Haneda.” However, the Office Action has mischaracterized the “purpose” of Fowler and Gouko. Fowler and Gouko describe a

display device with extended or extendible sub panels. They do not describe extending the sub panels during operation, and without this description, their purpose cannot be “extending” but rather using the extended sub panels. Therefore, Office Action has not provided a teaching or suggestion to combine Fowler, Gouko, Rebeske, and Haneda. Applicant respectfully submits that the Office Action has engaged in an improper hindsight analysis of the rejected claims.

Additionally, the cited combination does not teach or suggest each and every element of the rejected claims. Independent claim 13 teaches a displaying “ a secondary set of information for the computer automatically upon extension of the secondary display device.” As noted above, Fowler and Gouko do not teach a secondary set of information, nor do they teach displaying the secondary set of information upon extension of the secondary display device. The Office Action does not point to any passages in Haneda or Rebeske that teach or suggest displaying a secondary set of information on a secondary display device. Instead, both Haneda and Rebeske teach displaying the same information on two different displays. Independent claims 34 and 41 include similar limitations. As such, Applicant respectfully submits that the cited combination does not teach or suggest each and every element of independent claims 13, 34 and 41.

Dependent claims 16, 21, 17, 39, and 40 depend directly or indirectly from claims 13 and 34. All of these claims include limitations discussed above. As noted above, Fowler, Gouko, Rebeske and Haneda neither alone nor in combination, teach or suggest the claim limitations. As such, Applicant respectfully submits that the cited combination does not teach or suggest each and every element of dependent claims 16, 17, 21, 39, and 40.

Claims 22, 25, 26, 30, 31, 32, and 35 were rejected under 35 USC §103(a) as being unpatentable over Fowler in view of Gouko, Rebeske, Haneda and Hendry et al. (U.S. 5682529, hereinafter referred to as Hendry). Applicant respectfully traverses this rejection.

As noted above, the Office Action does not provide a teaching or suggestion to combine the Fowler, Gouko, Rebeske and Haneda. The Office Action asserts that it would have been obvious to the skilled artisan at the time of the invention to modify the computer display device as taught by Rebeske by including software as suggested by Hendry and Haneda to reconfigure the display systems. However, since the Office Action does not point to any passage that provides teaching or suggestion to combine the references. Without such a teaching or

motivation to combine the cited references, the Office Action has engaged in an improper hindsight analysis of the rejected claims.

Additionally, the cited combination does not teach or suggest each and every element of the rejected claims. Independent claim 22 teaches “when the at least one secondary display device can be extended from the housing and used to display primary and secondary information.” As noted above, Fowler and Gouko do not teach limitations for a secondary display device that is used to display the secondary set of information. In order for Fowler, Gouko, Rabeske, Haneda, and Hendry to teach or suggest all of the claimed limitations of independent claim 22, Rabeske, Haneda or Hendry must teach what Fowler and Gouko are lacking. However, the Office Action has not pointed to any passage in Rabeske, Haneda, or Hendry that teaches: “when the at least one secondary display device can be extended from the housing and used to display primary and secondary information.” Independent claims 30 and 32 include similar limitations.

Independent claim 22 also teaches “displaying a reconfiguration screen on the primary display device.” The Office Action asserts that Hendry’s figure 3 is an example of a structure for a display notification is illustrated. However, Applicant respectfully submits that the Office Action has mischaracterized Hendry’s figure 3. Hendry’s structure is a data structure containing information for the operating system and other software programs, not for user input. “The information that is provided to the operating system and other software programs by the display manager, in response to a change in configuration, comprises a list of pairs of display state descriptors. An example of a structure for a display notification is illustrated in FIG. 3.” Hendry Column 5, Lines 55-60. Therefore, the structure would not be shown, as the Office Action asserts “to the user for input and notice of said configuration.” Additionally, the Office Action does not point to any passage in Hendy that points out a reconfiguration screen.

Independent claim 30 teaches “transmitting a reconfiguration signal to a computer” and “reconfiguring the computer such that the computer displays primary application information in the primary display device to increase a viewing area in the primary display device for the primary application information.” The Office Action does not point to any passages in the cited combination that teach or suggest these limitations. For the forgoing reasons, Applicant

respectfully submits that the combination of Fowler, Gouko, Rabeske, Haneda, and Hendry do not teach or suggest each and every element of independent claims 22, 30 and 32.

Dependent claims 25, 26, 31, 35, and 38 depend directly or indirectly from claims 22, 30, and 32. As such, Applicant respectfully submits that the combination does not teach or suggest each and every element of dependent claims 25, 26, 31, 35, and 38.

Claims 3-5, 7-10, 14, 15, 18-20, 28, 36, and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fowler, Gouko, Rebeske, Haneda, Hendry and Failla (U.S. 5128662, hereinafter referred to as Failla.) Applicant respectfully traverses this rejection.

As noted above, the Office Action has not provided a reason to combine Fowler, Gouko, Rebeske, Haneda, and Hendry. The Office Action also does not point out a suggestion to combine them with Failla.

Additionally, regarding claims 8, 9, 10, 19, 20, and 28, the Office Action asserts that Failla teaches an inverter board. Applicant has found no passage in Failla that teaches an inverter board. The Office Action also asserts that "said conductive path and reconfiguration are inherent the device of Fowler and Gouko." As noted before, Fowler and Gouko do not teach reconfiguration. As such, Applicant respectfully submits that the cited combination does not teach or suggest each and every element of the rejected claims.

Reservation of Rights

Applicant does not admit that references cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such references should not be construed as admissions that the references are prior art.

Conclusion

Based on the foregoing, Applicant respectfully requests that the rejections be withdrawn. Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 371-2169 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

SUSAN R. SALL

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 371-2169

Date 5/3/04

By Andrew DeLizio
Andrew DeLizio
Reg. No. 52,806

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 3 day of May 2004.

Candy Buending

Name

Signature